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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Kazuhito FUJII et al.

Group Art Unit: 1787

Application No.: 10/553,724

Examiner: K. KRUER

Filed: October 19, 2005

Docket No.: 125723

For: COVER TAPE FOR TAPE-PACKAGING ELECTRONIC COMPONENTS

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

After entry of the Notice of Appeal filed herewith, Applicant requests review of the Rejection mailed November 24, 2010 in the above-identified application.

**I. Status of Pending Claims**

Claims 1, 2, 6, 8 and 9 are pending in this application. No amendments are being filed with this Request.

**II. Grounds of Rejection Presented for Review**

The Office Action rejects claims 1, 2, 6, and 8 under 35 U.S.C. §102(b) over Miyamoto et al. (JP 08-25888, hereinafter "Miyamoto").

Applicants' traversal of the rejections and supporting arguments were made of record in the Amendment filed November 18, 2010 and Supplemental Response filed December 3, 2010. Applicants respectfully request review of the rejection in light of the remarks made in the November 18 Amendment and December 3 Supplemental Response, with particular emphasis on the following points.

The Office Action asserts (1) that the cover tape of Miyamoto comprises the same layers having the same composition as the claimed film (see Office Action, page 3), (2) that the range of melting points of the alpha-olefin copolymer disclosed in Miyamoto (110°C or less) is equivalent to or overlaps with the recited range of softening temperatures of the claimed metallocene linear low-density polyethylene (see Office Action, pages 2 and 3), and (3) that "the examiner takes the position that the m-LLDPE taught in Miyamoto which has a density in the overlapping claim range (0.90-0.907) will inherently meet the claimed softening point since said polymers are compositionally identical to the claimed polymers" (see Office Action, page 3). Applicants respectfully disagree.

The Office Action also asserts that there is no evidence that the m-LLDPE of Miyamoto fails to meet the claimed softening point limitations (see Office Action, page 4). However, Applicants filed a Declaration under 37 C.F.R. § 1.132 (Declaration) with the December 3 Supplemental Response, which is, itself, evidence that must be considered. The Office Action fails to specifically explain why the evidence set forth in the Declaration is insufficient. Therefore, the Office Action improperly fails to consider Applicant's rebuttal evidence and thus, for at least this reason, the rejection is improper and should be withdrawn.

In response to Applicants' arguments that the density and melting point do not directly correlate, the Office Action acknowledges that there is no evidence that the polymers in the tables of the specification and Comparative Example 1 of Miyamoto are identical or even comprise the same copolymers. See Office Action, page 4. For similar reasons, Applicants submit that there is also no evidence that the polymers disclosed in Miyamoto are identical to the recited metallocene linear low-density polyethylene, much less necessarily possess all of the properties and characteristics of the recited metallocene linear low-density polyethylene.

To the extent the Office Action asserts the claimed features are present in Miyamoto based on inherency, such bases are not properly established and are thus improper.

Specifically, it is improper for the Office Action to rely on inherency (see Office Action, page 3) to establish that Miyamoto discloses "the metallocene linear low-density polyethylene has a specific gravity in a range of from 0.888 to 0.907, wherein a softening temperature of the metallocene linear low-density polyethylene measured by a TMA method defined in JIS K7196 is in a range of from 75°C to 97°C," as recited in claim 1, because there is no evidence that the polymers disclosed in Miyamoto **necessarily** possess all of the properties and characteristics of the metallocene linear low-density polyethylene recited in claim 1, which is required to support an inherency rejection.

As is well settled:

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. **Inherency, however, may not be established by probabilities or possibilities.** The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'

*In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted). Furthermore, MPEP §2112(IV) states “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”

*Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)."

There is no evidence that the polymers of Miyamoto are not compositionally identical to the recited metallocene linear low-density polyethylene, much less any basis in fact and/or technical reasoning on the record to reasonably support that the polymers of Miyamoto inherently possess equivalent softening temperatures within the claimed range.

The Declaration demonstrates that simply because the ethylene-alpha-olefin copolymer disclosed in Miyamoto has a melting point of 110°C or less does not necessarily indicate that the softening temperature of the ethylene-alpha-olefin copolymer falls within the

recited range of softening temperatures in claim 1 or that the method disclosed in Miyamoto would necessarily produce an ethylene-alpha-olefin copolymer having the recited range of softening temperatures in claim 1.

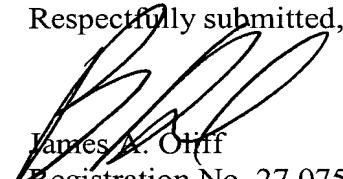
For example, comparative Example 1 of Table 2 of Miyamoto and Comparative Example 1 of the present specification both have a density of 0.908 g/cm<sup>3</sup>; however, these examples have different melting points and thus must not be compositionally identical. Specifically, as noted in the Declaration, Comparative Example 1 in Table 2 of the present specification and Comparative Example 1 in Table 2 of Miyamoto both have densities of 0.908 g/cm<sup>3</sup>, yet Comparative Example 1 of the present specification has a softening temperature of 104.3°C (and a DSC melting point of 104°C) and Comparative Example 1 of Miyamoto has a melting point of 120°C. Thus, given the facts presented in the Declaration, one may not presume or infer that similarities in densities of LLDPEs necessarily indicate that the polymers of Miyamoto are *compositionally identical*, much less inherently possess equivalent softening temperatures within the claimed range.

Furthermore, as discussed on page 13 of the present specification and in the Declaration, the claimed properties of the claimed metallocene LLDPE require careful control of the molecular structure (including the molecular weight range) of the claimed metallocene LLDPE (see page 13, lines 26-35, of the present specification), which is not even suggested in Miyamoto. Although Miyamoto discloses that the melting point of the ethylene-alpha-olefin copolymer is 110°C or less, without careful control of the molecular structure, this range of melting points does not necessarily mean that a copolymer with a softening temperature in the range of 75°C to 97°C will be present. Miyamoto does not provide any examples that show that the ethylene-alpha-olefin copolymer has a softening temperature ranging from 75°C to 97°C. Thus, the rejection is also improper because the claimed subject matter is not disclosed in Miyamoto with sufficient specificity to constitute anticipation under the statute.

Therefore, for at least the reasons presented above, and in view of the evidence presented in the Declaration, Miyamoto fails to disclose, either expressly or inherently, the claimed subject matter and thus does not anticipate claims 1, 2, 6, 8 and 9. Accordingly, the rejection of the claims over Miyamoto is improper and should be withdrawn.

**III. Conclusion**

For at least the reasons discussed above and made of record, it is respectfully submitted that the Rejection is predicated upon legal and factual deficiencies, and that all the pending claims are in condition for allowance. Withdrawal of the Final Rejection and allowance of this application are respectfully requested.

Respectfully submitted,  
  
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JAO:BSP

Attachment:  
Notice of Appeal

Date: February 22, 2011

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